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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/662,718	09/15/2000	Timothy A. Wurtz	SFN-301RI	1956

7590 06/18/2002

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EXAMINER

GLESSNER, BRIAN E

ART UNIT

PAPER NUMBER

3635

DATE MAILED: 06/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/662,718	WURTZ ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Brian E. Glessner	3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 29 March 2002.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-3 and 5-20 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 1-3 and 5-11 is/are allowed.

6) Claim(s) 12,14,15 and 17-20 is/are rejected.

7) Claim(s) 13 and 16 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 15 September 2000 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>8</u> .	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION*****Reissue Applications***

Claims 12, 14, 19, and 20 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Recapture exists in the above claims because said claims have omitted the limitations that were presented or argued to obviate the rejection in the original application. Claim 4 of the original application was indicated by the examiner as being allowable because claim 4 contained the limitation of a plurality of nail posts attached to the side of the floor joist retainer body, each positioned and configured to hold a nail with a pointed end extending into a form, and a plurality of nails positioned within the nail posts and configured in size to extend a pointed end into a form. Further, in the applicant's response filed on February 9, 1998 in application serial no. 08/857,109, the applicant argued that the limitation of a removable top was allowable over the

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prior art. Since claims 12, 14, 19, and 20 do not contain either of the above limitations, recapture of broadened claimed subject matter exists.

The examiner would also like to remind the applicant that the original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

***Claim Rejections - 35 USC § 102***

1. Claims 15, 17, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Crofoot (3,894,368).

In regard to claim 15, Crofoot discloses a floor joist retainer, for use in a concrete foundation formed by pouring concrete into forms, which comprises:

a floor joist retainer body 1 having an open front, closed sides, a back, a bottom, and a top, at least one cut 8 being provided on the floor joist retainer body where the top connects to the sides and back so that the top is removable, the floor joist retainer body being configured to receive and support an end of a floor joist positioned within the floor joist retainer body through the top and front, the top being attached to the floor joist retainer body when the concrete is poured into the forms and removable after the concrete is poured;

a retaining flange 3 attached to the floor joist retainer body for engagement within the concrete foundation; and

removable means 6 for removably attaching the floor joist retainer body to the forms before the concrete is poured into the forms. The examiner would like to point out that the applicant has not provided any structure for his "cut". Therefore, the examiner contends that the "cut" is located at the location indicated by the reference number 8. The applicant has not

provided any structural features, i.e. a cut having a thickness which is less than a thickness of a side wall, that would define the cut over merely a line on the side of the retainer. Thus, the examiner contends that Crofoot discloses the claimed invention.

In regard to claim 17, Crofoot discloses the claimed invention, wherein the removable means for attaching the floor joist retainer body to the form comprises a plurality of nails.

In regard to claim 18, Crofoot discloses the claimed invention, wherein the floor joist retainer body is formed of material to which poured concrete will not adhere, i.e. plastic.

***Response to Arguments***

1. Applicant's arguments filed 3/29/02 with respect to claims 15, 17, and 18 have been fully considered but they are not persuasive.

The applicant argues that Crofoot does not disclose a cut where the top connects to the sides so that the top is removable. The examiner respectfully disagrees because the applicant has not provided any structure that specifically defines the cut, i.e. a cut having a thickness that is less than a thickness of a side wall. The applicant argues that it would not be obvious to incorporate a cut having a diminished thickness into Crofoot's invention, but this limitation is not found in the claim. The applicant merely recites a cut. The examiner contends, as disclosed above in the rejection of claim 15, that Crofoot does disclose a "cut" 8 located at the place where the top meets the walls.

***Allowable Subject Matter***

2. Claims 1-3 and 5-11 are allowed.
3. Claims 13 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base

claim and any intervening claims. This holding of allowable subject matter is provisional and subject to reconsideration upon receipt of the amended claims to comply with the specifications set forth in 35 U.S.C. 112, second paragraph.

The following is a statement of reasons for the indication of allowable subject matter: Claims 1, 7, 11, 13, and 16 are allowable for the reasons set forth in the previous office action. Claims 5, 8, and 9 are allowable for the reasons set forth by applicant in the response filed on 3/29/02 .

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Glessner whose telephone number is 703-305-0031. The examiner can normally be reached on Monday-Friday 6:30-5:00 alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on 703-308-0839. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3597 for regular communications and 703-305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

B.G.  
June 5, 2002

  
**BRIAN E. GLESSNER**  
**PATENT EXAMINER**